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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,890	01/23/2002	Yehouda Harpaz		8217

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,890

Applicant(s)

HARPAZ, YEHOUDA *JH*

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Information Disclosure Statement

While a search report and documents were included with the patent application, a proper IDS form was not filed in accordance with 37 C.F.R. §1.97 and §1.98.

Claim Objections

Claims 1 and 2 are objected to because of the following informalities:

The claims contain italics as well as lack spaces between the references characters and the words that describe them.

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

The claims also contain capitalized letters throughout. The claims should represent one sentence, starting with a capital letter and ending with a period.

The claims do not follow the requirements of 37 C.F.R. §1.75 (i) stating that where a claims sets forth a plurality of elements or steps, each element or step of the claims should be separate by a line indentation.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the contents of the game manager (CPU, memory, program) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 includes the limitation of a computer program. Such language is non-statutory as it does not tangibly embody the program on a medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a computer program. This recitation is indefinite in that one of ordinary skill in the art would not understand the purpose or functionality of the program. Without stating

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what the purpose of the program is or what it does, a skilled artisan would not be able to ascertain its purpose in the system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (US Patent No. 5,417,425) further in view of Lites Out!

Blumberg et al. disclose a grid of grid points on a flat surface where each grid point is a visible element (FIG 1-4) which is capable of detecting when it is pressed (Column 1, lines 22-30). Blumberg et al. also disclose an illumination source inside and below the surface which is capable of illuminating the visible element (FIGs 13-14) by either of two colors (Column 6, lines 37-40). Blumberg et al. disclose a game manager (FIG 9) connected electronically to the grid points (FIG 9, reference 20) as well as to the illumination source (FIG 9, reference 30). The microcontroller has control over the illumination and coloring of the squares (Column 4, lines 11-

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14). It also detects when a grid point is pressed (Column 4, lines 11-14). FIG 9 also shows a program and a memory associated with the CPU (microcontroller).

The CPU manages the game and when a player presses a point, the illuminations of a pattern of points around this point are changed (Abstract).

Blumberg et al. discloses that the CPU uses a program to control the illuminations and patterns. Though Blumberg et al. discloses two colors for use in the game, the disclosure does not explicitly state that when a player presses a point, the colors change to a player color if they were switched off or reverse colors if they were on. However, Lites Out! which is a mimic of the Blumberg et al. patent with an improvement consisting of using two colors and an off state does make the changes as claimed. By using two colors and an off state, Lites Out! uses such a twist to make the game harder. Thus, the game would be more enjoyable to more experienced players who would less likely to tire of the game upon mastery. By adding a third color, thus a higher level of difficulty, one skilled in the art would recognize the added and lasting enjoyment that could be obtained. The function of the lights is disclosed as follows: In this mode, the object is the same, but each block can have 3 states; OFF, ON1 (yellow), or ON2 (blue). The direction the blocks change depends on the direction it was going and the state of the main block that is being switched. Thus, colors are either switched on or reversed depending on the state they were in.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the program disclosed by Lites Out! into a structure such as the one disclosed by Blumberg et al. As Lites Out! merely represents a program, it could easily be adapted or used by a skilled artisan to work in the structure of Blumberg et al. wherein its addition would add lasting enjoyment to the device. As Blumberg et al. already support multiple color lights as well as an off state, one would be motivated to do this, as discussed above, to provide a more challenging

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and testing device to continue to face and amuse experienced players; thereby, not alienating them when they learn and grow tired of the simplified Blumberg et al device.

Blumberg et al. also states that the objective is to go from a starting configuration of indicator states to a desired configuration of indicator states (Column 2, lines 22-24). Blumberg et al. follows with the example of an ending configuration where all the indicators are of the same state, i.e. lit (Column 2, lines 25-30). Blumberg et al. is very open about what the goals can be and designates other possible ending configurations, thus indicating other such ending points would be of a design choice. In the above named case, the player would have the majority of the lights on, as that would be the ending phase.

Blumberg et al. also does not disclose a character display. However, Bloomberg et al. does disclose an audio device, which is used to provide feedback information (Column 4, lines, 15-17). It would be obvious to a skilled artisan that in providing feedback, the device would indicate a win, as is known in the art, in order to stimulate the player and provide encouragement and recognition. Further, it would have been an obvious design choice to employ a display as opposed to an audio device as both satisfy the requirement of providing feedback to the player. One motivation for using a character display would be that the player could play the game without disturbing others (i.e. in cars, planes, or trains), yet still receive feedback. This device would be used in the Blumberg et al. system to indicate to the player they are the winner as all the points are switched on and therefore have the majority.

Regarding claim 2, Blumberg et al. states that the determination of which indicators change state upon the selection of one of the indicators is made based on the preset pattern or algorithm (Column 3, lines 5-7) and also states that the device can change the state of at least one of the non-selected indicators, perhaps also changing state of a selected indicator (Column 3, lines 1-3) thus suggesting that the board performs changes only when an non-illuminated

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point is pressed as Blumberg et al. indicates it is not required that the state of a selected indicator must be changed, it is only requires that at least a non-selected indicator be changed.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg et al. (US Patent No. 5,417,425) further in view Othello (Shadows125 Java Applet).

What Blumberg et al. discloses, teaches, and/or suggest has been discussed above and is incorporated herein.

The well-known game of Othello obviates the use of such an electronic game wherein two-colors and an off state are used in the manner disclosed. Othello also offers an electronic version, thus providing a program, wherein there is a grid of grid points on a flat surface wherein each grid points is a visible element which is capable of detecting when it is selected. It offers two colors and a character display. The program has control and is notified when any grid point is selected. When a selection occurs, the program either sets an off state to a player's color or changes opponent's colors if they are around the point. When all the points on the board are used, the program using the character display, declares, as the winner, the player with the majority of the points.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the program disclosed by Othello into a structure such as the one disclosed by Blumberg et al. As Othello merely represents a program, it could easily be adapted or used by a skilled artisan to work in the structure of Blumberg et al. wherein its addition would add lasting enjoyment to the device. As Blumberg et al. already support multiple color lights as well as an off state, one would be motivated to do this, as discussed above, to provide a more challenging and testing device to continue to face and amuse experienced players; thereby, not alienating them when they learn and grow tired of the simplified Blumberg et al device.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

British Othello Federation ®: Describes the rules of the known game of Othello and how the game is played.

US Patent No. 5,603,500: Puzzle device that allows for the user to press buttons and change the color of the state and the surrounding buttons.

GB 2 334 680: Electronic game board comprises an array of grid points and a controller. The board can be programmed with a variety of games.

US Patent No. 5,743,796: Game with a plurality of spaces with indicators and a game for uses lights to control states.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.



cmm
January 15, 2004



**MICHAEL O'NEILL
PRIMARY EXAMINER**